



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

On Appeal from Group: 1612

Jean DE RIGAL et al.

Application No.: 10/743,455

Examiner: B. PACKARD

Filed: December 23, 2003

Docket No.: 118111

For: COSMETIC COMPOSITIONS AND CONTRAST CARDS FOR CHARACTERIZING
THEM

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
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Sir:

Attached is the Brief on Appeal in the above-identified application.

Also attached is Check No. 211877, in the amount of \$540.00 (\$270.00 Small Entity), in payment of the fee due under 37 C.F.R. 41.20(b)(2).

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Jean DE RIGAL et al.

Group Art Unit: 1614

Application No.: 10/743,455

Examiner: F. KRASS

Filed: December 23, 2003

Docket No.: 118111

For: COSMETIC COMPOSITIONS AND CONTRAST CARDS FOR CHARACTERIZING
THEM

BRIEF ON APPEAL

Appeal from Group 1614

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is L'Oreal, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 015162, Frame 0021.

II. RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or that will directly affect or be directly affected by or have a bearing upon, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-15 and 34-38 are on appeal.

Claims 1-31 and 34-38 are pending.

No claims are allowed, and no claims are objected to only for being dependent from a rejected base claim, but otherwise indicated to be allowable.

Claims 1-15 and 34-38 are rejected.

Claims 16-31 are withdrawn from consideration.

Claim 32 is canceled in an Amendment filed concurrently herewith.

IV. STATUS OF AMENDMENTS

The Amendment filed on October 29, 2007 has been entered. Appellants concurrently filed herewith an Amendment After Final Rejection that cancels independent claim 32.

Because the Amendment reduces the issues on appeal by canceling rejected independent claim 32, it is expected that the Amendment will be entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1-15 and 34-38 generally relate to a foundation cosmetic composition capable of lightening dark skin while creating a natural-looking appearance on the user, and a method of making up skin by using the foundation cosmetic composition. See specification, paragraphs [0007] and [0018]. The foundation cosmetic composition has both a homogenization power ($1/\Delta E_{1 \text{ mean}}$) within a specified range and a covering power ($1/\Delta E_2$) within a specified range when the composition is applied, according to a value of its lightness L^* , to a defined contrast card. See specification, paragraphs [0023] to [0025]. The claimed foundation cosmetic composition is particularly, but not exclusively, intended for dark skins, including black and mixed-race skins. See specification, paragraph [0002].

The claimed invention offers the advantage that making up one's face with a foundation cosmetic composition that has the recited combination of homogenization power and covering power will allow a user to achieve desired effects such as masking skin defects, while allowing the skin to conserve a natural-looking appearance. See specification, paragraph [0256].

A. Claim 1

The composition according to claim 1 comprises, in a physiologically acceptable medium, at least one coloring agent that has a yellow or orange coloration and a significant reflectance in the range from 550 to 675 nm, and reflective particles. See specification, paragraphs [0087] and [0107]. In addition, the composition according to claim 1 has a reflectance ranging from 10 to 45% in the range from 600 to 680 nm. See specification, paragraph [0016]. The composition has a specific combination of homogenization power and covering power when applied, depending on the value of its lightness L^* , to one of three contrast cards. See specification, paragraphs [0023] and [0024]. The contrast cards are identified by their defining properties in claim 1, and are entitled contrast cards 32, 31 and 30.

See specification, paragraphs [0050] to [0076]. For the composition having a lightness L^* of between 30 and 40, with reference to card 32, the homogenization power is between about 1.1 and about 6.7, and the covering power is between about 0.25 and 0.84. See specification, paragraph [0023]. For the composition having a lightness L^* of between 40 and 50, with reference to card 31, the homogenization power is between about 1.1 and about 1.54, and the covering power is between about 1/9 and 1/5. See *id.* For the composition having a lightness L^* of between 50 and 60, with reference to card 30, the homogenization power is between about 0.8 and about 1.25, and the covering power is between about 1/7 and 1/3. See *id.*

1. Contrast Card 32

Contrast card 32, the first card addressed in claim 1, is representative of skins having a lightness value L^* between 30 and 40. See specification, paragraph [0068]. Accordingly, the homogenization power and covering power of a composition having a lightness value L^* between 30 and 40 are defined with reference to contrast card 32. Contrast card 32 comprises colored zones B11+, B11, B12, B12+ and XXX, and a white border. See specification, paragraph [0055]. The colored zones may correspond to mean colors observed on a panel of individuals having a dark skin with a dark complexion for different regions of the face, such as on the cheekbones, on the forehead, under the outer eye, under the middle of the eye and under the inner eye. See specification, paragraphs [0069] to [0071]. When the composition having a lightness L^* of between 30 and 40 is applied to a contrast card having the coordinates in the CIE 1976 colorimetric space below, to within 15% of L^* and hue angle value h , and to within 25% of saturation C^* :

Zone	B11+	XXX	B12+	B12	B11
L^*	36.7	29.63	32.98	35.66	38.43
C^*	19.81	15.06	17.29	19.78	21.76
H	47.34°	40.34°	44.64°	46.32°	46.51°

the composition can be seen to have a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between about 1.1 and about 6.7, and a covering power $1/\Delta E_2$ of between about 0.25 and about 0.85, wherein $\Delta E_{1 \text{ mean}} = (\Delta E_{1 \text{ B11/B11+}} + \Delta E_{1 \text{ B12/B11+}} + \Delta E_{1 \text{ B12+/B11+}} + \Delta E_{1 \text{ XXX/B11+}})/4$; and wherein ΔE_2 is the colorimetric difference between zone B11+ and the white border. See specification, paragraph [0072].

2. Contrast Card 31

Contrast card 31, the second card addressed in claim 1, is representative of skin having a lightness L^* value of between 40 and 50. See specification, paragraph [0063]. Therefore, the homogenization power and covering power of a composition having a lightness value L^* of between 40 and 50 are defined with reference to contrast card 31. Contrast card 31 comprises colored zones C9, B12, C11, C10 and C8, and a white border. See specification, paragraph [0054]. The colored zones of the contrast card 31 may correspond to mean colors observed on a panel of individuals having a dark skin with a medium complexion for different regions of the face, such as the cheekbones, on the forehead, under the outer eye, under the middle of the eye, and under the inner eye. See specification, paragraphs [0064] to [0067]. When the composition having a lightness L^* of between 40 and 50 is applied to contrast card 31 having the coordinates in the CIE 1976 colorimetric space below, to within 15% of L^* and hue angle value h , and to within 25% of saturation C^* :

Zone	C9	B12	C11	C10	C8
L^*	45.04	35.66	38.73	42.19	48.06
C^*	25.18	19.78	21.94	24.18	25.97
h	53.27°	46.32°	50.18°	51.94°	53.09°

the composition can be seen to have a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between about 1.1 and about 1.54, and a covering power $1/\Delta E_2$ of between about 1/9 and 1/5, wherein $\Delta E_{1 \text{ mean}} =$

$(\Delta E_{1\ C8/C9} + \Delta E_{1\ C10/C9} + \Delta E_{1\ C11/C9} + \Delta E_{1\ B12/C9})/4$; and wherein ΔE_2 is the colorimetric difference between zone C9 and the white border. See specification, paragraph [0073].

3. Contrast Card 30

Contrast card 30, the third card addressed in claim 1, is representative of skins having a lightness value L^* of between 50 and 60. See specification, paragraph [0060].

Accordingly, the homogenization power and covering power of the composition having a lightness value L^* between 50 and 60 are defined with reference to contrast card 30. Contrast card 30 comprises a colored zones D6, C11, D8, D7 and D5, and a white border. See specification, paragraph [0053]. The colored zones of contrast card 30 may thus correspond to mean colors observed on a panel of individuals having a dark skin with a fair complexion for different regions of the face, such as the cheekbones, on the forehead, under the outer eye, under the middle of the eye and under the inner eye. See paragraphs [0061] and [0062].

When the composition having a lightness L^* of between 50 and 60 is applied to a contrast card having the coordinates in the CIE 1976 colorimetric space below, to within 15% of L^* and hue angle value h , and to within 25% of saturation C^* :

Zone	D6	C11	D8	D7	D5
L^*	54.08	38.73	47.94	51.79	57.61
C^*	26.70	21.94	26.18	27.21	26.22
h	57.35°	50.18°	56.82°	57.09°	55.09°

the composition can be seen to have a homogenization power $1/\Delta E_{1\ mean}$ of between about 0.8 and about 1.25 and a covering power $1/\Delta E_2$ of between about 1/7 and 1/3, wherein $\Delta E_{1\ mean} = (\Delta E_{1\ D5/D6} + \Delta E_{1\ D7/D6} + \Delta E_{1\ D8/D6} + \Delta E_{1\ C11/D6})/4$; and wherein ΔE_2 is the colorimetric difference between zone D6 and the white border.

In connection with all three contrast cards, L^* , C^* and h refer to coordinates in the CIE 1976 colorimetric space, wherein $\Delta E_{1\ M/N} = [(a_M^* - a_N^*)^2 + (b_M^* - b_N^*)^2 + (L_M^* -$

$L_N^*)^2]^{1/2}$; and wherein a^* and b^* are coordinates in the CIE 1976 colorimetric space. See specification, paragraph [0074].

B. Claim 2

The composition according to claim 2 comprises, in a cosmetically acceptable medium, at least one coloring agent that has a yellow or orange coloration and a significant reflectance in the range from 550 to 675 nm, and reflective particles. See specification, paragraphs [0087] and [0107]. In addition, the composition according to claim 2 has a reflectance ranging from 10 to 45% in the range from 600 to 680 nm. See specification, paragraph [0016]. The composition has a homogenization power and a covering power in a specific range when the composition is applied to a contrast card, which is identified by its defining properties in claim 2, and is entitled contrast card 10. See specification, paragraph [0024]. In particular, the homogenization power is between about 1/4 and 1, and the covering power is between about 1/25 and 1/7. See *id.*

1. Contrast Card 10

Contrast card 10 comprises six defined colored zones, Z1-Z6, and a white border. See specification, paragraphs [0077] and [0078].

The various zones Z1 to Z6 may correspond to mean colors observed on a panel of individuals having a dark skin, for example a skin belonging to a given type of black skin, for different regions of the face and the body. Skins with a lightness of between 45 and 50 (fair-tone dark skins), between 39 and 44 (medium-tone dark skins), and less than 39 (dark-tone dark skins) may be considered, for example, as being of the same type. See specification, paragraph [0080].

Zones Z1 to Z5 may correspond, for example, respectively, to the mean color measured on the forehead, the bags under the eyes, the space between the nose and the lips, and also on marks on the face, especially marks present on the cheeks, and the zone Z6 to the

color measured on the body, for example the underside of the forearm. See specification, paragraph [0081].

The following values can be measured for each zone of card 10:

Zone	Z1	Z2	Z3	Z4	Z5	Z6
L*	48.38	46.67	44.5	42.72	44.41	52.26
a*	7.99	6.78	6.76	4.12	6.57	9.11
b*	3.85	3.25	3.1	2.57	3.93	5.81

The composition of claim 2, when applied to contrast card 10, can be seen to have a homogenization power $1/\Delta E_{1\text{mean}}$ of between 1/4 and 1, and a covering power $1/\Delta E_2$ of between 1/25 and 1/7 wherein $\Delta E_{1\text{mean}} = (\Delta E_{1\text{ zone Z1/Z6}} + \Delta E_{1\text{ zone Z2/Z6}} + \Delta E_{1\text{ zone Z3/Z6}} + \Delta E_{1\text{ zone Z4/Z6}} + \Delta E_{1\text{ zone Z5/Z6}})/5$ with $\Delta E_{1\text{ zone Zi/Z6}} = [(a^*_{Zi} - a^*_{Z6})^2 + (b^*_{Zi} - b^*_{Z6})^2 + (L^*_{Zi} - L^*_{Z6})^2]^{1/2}$, for $i = 1, 2, \dots, 5$, wherein ΔE_2 is the colorimetric difference between the sixth zone (Z6) and the white border; and wherein L*, a* and b* refer to coordinates in the CIE 1976 colorimetric space.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

Claims 1-15 and 34-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bourjois et al. (FR 2 178 441; "Bourjois") in view of MacFarlane et al. (U.S. Patent No. 5,313,267; "MacFarlane"). Independent claim 32 was also rejected in this rejection; however, in view of the cancellation of claim 32 in the Amendment filed herewith, claim 32 is not further addressed herein.

VII. ARGUMENT

The Examiner rejects pending claims 1-15 and 34-38 under 35 U.S.C. §103(a) as being unpatentable over Bourjois in view of MacFarlane. However, the Examiner misconstrues the facts and improperly applies the law relating to obviousness. Proper application of the law to the facts demonstrates that no *prima facie* case of obviousness has been shown, and that the claimed invention would not have been obvious over the applied references. In particular, (1) the combined teachings of Bourjois and MacFarlane fail to disclose or establish a reason to provide every limitation any of the claims; (2) combining the teachings of Bourjois and MacFarlane is improper; and (3) the Examiner fails to establish a *prima facie* case of obviousness of the claims and has improperly shifted the initial burden of proving non-obviousness to Appellants.

A. Factual Inquiries To Determine Obviousness/Non-Obviousness

Several basic factual inquiries must be made in order to determine obviousness or non-obviousness of claims of a patent application under 35 U.S.C. §103. These factual inquiries are set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966):

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations are commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances.

The specific factual inquiries set forth in *Graham* have not been considered or properly applied by the Examiner in formulating the rejection of the subject claims. Particularly, the scope and content of the prior art and the level of ordinary skill in the pertinent art were not properly determined and demonstrated and applied to the claimed invention.

Proper consideration of the factual inquiries demonstrates non-obviousness of the claimed invention.

**B. The Combined Teachings Of Bourjois And MacFarlane
Fail To Disclose Or Establish A Reason To Provide
Every Limitation Of Independent Claim 1**

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a foundation cosmetic composition comprising the claimed combinations of components and properties of independent claim 1.

Bourjois fails to disclose or establish any reason to provide any foundation cosmetic composition, much less a cosmetic composition comprising the claimed combinations of components and properties of independent claim 1. To the contrary, Bourjois describes a method of selecting the most flattering category of colors of cosmetic products, by superimposing various transparent templates selected based on the shape of a user's face, eyes, lips eyebrows, eye color, and "the nature of her skin," the colors categorized generally as having a "light", "medium" or "dark" hue. See page 2, lines 10-17. The templates then indicate the category of colors that are most flattering to the user. The user selects individual colors within the category indicated by the template. See page 3, paragraphs 6 to 8, and page 4, paragraphs 3-8.

Bourjois provides almost no information about any cosmetic composition. It merely teaches that makeup compositions may have tints, shades, and light, medium or dark hues. It discloses no specific compositions at all.

In particular, Bourjois provides no disclosure of or reason to provide:

- (1) any foundation cosmetic composition;
- (2) any such composition comprising a coloring agent having a yellow or orange coloration and the specified significant reflectance;
- (3) any such composition comprising reflective particles;
- (4) any such composition having a reflectance in the recited range;
- (5) any such composition having any of the recited lightness values;

(6) any such composition having the recited homogenization power relative to the recited lightness values; or

(7) any such composition having the recited covering power relative to the recited lightness values.

In other words, Bourjois does not disclose any composition meeting any of the limitations of claim 1. It certainly does not disclose any composition having the combination of limitations required by claim 1.

The Examiner acknowledges on page 6 of the June 29, 2007 Office Action that Bourjois "does not specify, *ipsissima verba*, selection of cosmetics based specifically on skin color (necessary to arrive at the particular lightness values recited by instant cla[i]ms 1-15 and 34-38)." The Examiner relies on MacFarlane by alleging that MacFarlane "provides methods for personal color characterization using skin color as the exclusive determining factor."

MacFarlane teaches "a method and instrument for identifying categories of skin coloration for compatibility with colors of clothing, makeup, etc., and more particularly to methods and apparatus for classifying skin color based upon its blue and yellow undertones and for assigning one of a plurality of basic categories for which compatible colors have been selected." See column 1, lines 19-25. MacFarlane further describes that "skin coloration is accurately measured in a consistent, repeatable fashion on the basis of blue and yellow undertones in any person's skin color, utilizing a known color evaluation device and calculating a single parameter dependent on the blue and yellow content." See column 2, lines 25-30.

MacFarlane also fails to teach or suggest a cosmetic composition comprising the claimed combination of the other above limitations of claim 1. While MacFarlane discloses at columns 14-15 that certain cosmetics may contain yellow or orange colorants, and makes reference to brown and beige foundation compositions at column 16, MacFarlane neither

discloses nor provides any reason to provide any of the other above limitations of claim 1, much less the recited combinations of those limitations.

Because the combined teachings of the applied references fail to disclose or establish any reason to provide every limitation of claim 1, much less the combination of those limitations, the combined teachings of Bourjois and MacFarlane would not have led one of ordinary skill in the art to consider obvious the composition of claim 1. The combined teachings of Bourjois and MacFarlane thus would not have rendered obvious independent claim 1 or the claims dependent therefrom.

Reconsideration and reversal of the rejection are respectfully requested.

C. The Combined Teachings Of Bourjois And MacFarlane Fail To Disclose Or Establish A Reason To Provide Every Limitation Of Independent Claim 2

The combined teachings of Bourjois and MacFarlane also fail to disclose or establish a reason to provide a foundation cosmetic composition comprising the claimed combination of the properties of independent claim 2.

As noted above, Bourjois fails to disclose:

- (1) any foundation cosmetic composition;
- (2) any such composition comprising a coloring agent having a yellow or orange coloration and the specified significant reflectance;
- (3) any such composition comprising reflective particles;
- (4) any such composition having a reflectance in the recited range;
- (5) any such composition having any of the recited lightness values.

In addition, Bourjois similarly fails to disclose

- (6) any such composition having the recited homogenization power of claim 2; or
- (7) any such composition having the recited covering power of claim 2.

MacFarlane similarly fails to disclose or establish any reason to provide any of the other above limitations of claim 2, much less the recited combinations of those limitations.

Because the combined teachings of the applied references fail to teach or establish any reason to provide every limitation of claim 2, the combined teachings of Bourjois and MacFarlane would not have produced the composition of claim 2. The combined teachings of Bourjois and MacFarlane thus would not have rendered obvious independent claim 2 or the claims dependent therefrom.

Reconsideration and reversal of the rejection are respectfully requested.

**D. The Combined Teachings Of Bourjois And MacFarlane
Fail To Disclose Or Establish A Reason To Provide Every
Limitation Of Dependent Claims 3-9, 12-15 and 34-38**

The combined teachings of Bourjois and MacFarlane also fail to disclose or establish a reason to provide a foundation cosmetic composition comprising the claimed combination of the properties of dependent claims 3-9, 12-15 and 34-38.

1. Claim 3

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 2:

having a homogenization power $1/\Delta E_{l \text{ mean}}$ of between 1/1.6 and 1/2 and a covering power $1/\Delta E_2$ of between 1/12 and 1/15, as recited by claim 3. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific homogenization power or covering power, much less the combination of such features recited in this claim.

2. Claim 4

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 2:

having a homogenization power $1/\Delta E_{l \text{ mean}}$ of between 1/1.8 and 1/2.2 and a covering power $1/\Delta E_2$ of between 1/13 and 1/17, as recited by claim 4. Nothing in Bourjois or

MacFarlane discloses or establishes any reason to provide any specific homogenization power or covering power, much less the combination of such features recited in this claim.

3. Claim 5

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 2:

having a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between 1/1.6 and 1/2.1 and a covering power $1/\Delta E_2$ of between 1/12 and 1/16, as recited by claim 5. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific homogenization power or covering power, much less the combination of such features recited in this claim.

4. Claim 6

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 2:

having a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between 1/2.6 and 1/3 and a covering power $1/\Delta E_2$ of between 1/16 and 1/21, as recited by claim 6. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific homogenization power or covering power, much less the combination of such features recited in this claim.

5. Claim 7

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 2:

having a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between 1/1.7 and 1/2.2 and a covering power $1/\Delta E_2$ of between 1/9 and 1/13, as recited by claim 7. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific homogenization power or covering power, much less the combination of such features recited in this claim.

6. Claims 8 and 9

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 1 or 2:

being liquid at room temperature, as recited by claim 8 and 9, respectively. Neither reference provides any suggestion of its teachings being applicable to liquid cosmetics.

7. Claim 36

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 2:

having a homogenization power $1/\Delta E_{l \text{ mean}}$ of between 1/3 and 1/2, as recited by claim 36. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific homogenization power, much less the specific homogenization power recited in this claim.

8. Claim 38

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 2:

having a covering power $1/\Delta E_{2 \text{ mean}}$ of between 1/21 and 1/10, as recited by claim 38. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific covering power, much less the covering power recited in this claim.

9. Claim 14

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 1:

wherein the values of L^* and h are given with a tolerance selected from the group consisting of: within 12.5%, within 7.5%, and within 5%, as recited by claim 14. Nothing in either reference suggests selecting properties of a composition with reference to a color card at all, much less a color card having the specified properties.

10. Claim 15

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 1:

wherein the values of C^* are given with a tolerance selected from the group consisting of: within 20%, within 15%, within 10%, and within 5%, as recited in claim 15. Nothing in either reference suggests selecting properties of a composition with reference to a color card at all, much less a color card having the specified properties.

11. Claim 34

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 1:

wherein when the composition has a lightness of between 30 and 40, the composition has a homogenization power $1/\Delta E_{l \text{ mean}}$ of between about 1.25 and about 5, as recited in claim 34. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific lightness, homogenization power or covering power, much less the combination of such features recited in this claim.

12. Claim 35

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 1:

wherein when the composition has a lightness of between 40 and 50, the composition has a homogenization power $1/\Delta E_{l \text{ mean}}$ of between about 1.1 and about 1.43, as recited in claim 35. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific lightness, homogenization power or covering power, much less the combination of such features recited in this claim.

13. Claim 37

The combined teachings of Bourjois and MacFarlane fail to disclose or establish any reason to provide a composition of claim 1:

wherein when the composition has a lightness of between 40 and 50, the composition has a covering power of $1/\Delta E_{2\text{ mean}}$ of between 1/8 and 0.15, as recited by claim 37. Nothing in Bourjois or MacFarlane discloses or establishes any reason to provide any specific lightness, homogenization power or covering power, much less the combination of such features recited in this claim.

14. Claims 12 and 13

The combined teachings of Bourjois and MacFarlane also fail to disclose or establish any reason to provide any method for lightening dark skin, as recited by claims 12 and 13. The references are directed to identifying makeup that is compatible with skin color rather than to methods for lightening skin.

Because the combined teachings of the applied references fail to disclose or establish any reason to provide every limitation of any of claims 3-9, 12-15 and 34-38, the combined teachings of Bourjois and MacFarlane would not have led one of ordinary skill in the art to consider obvious the inventions of claims 3-9, 12-15 and 34-38. For this additional reason, the combined teachings of Bourjois and MacFarlane thus would not have rendered obvious claims 3-9, 12-15 and 34-38. Reconsideration and reversal of the rejection are respectfully requested.

E. Combining The Teachings Of Bourjois And MacFarlane Is Improper

The applied combination of references is improper because no reason or rationale exists for one of ordinary skill in the art to have combined the teachings of Bourjois and MacFarlane.

As discussed above, Bourjois describes a method of selecting the most flattering category of colors of cosmetic products, by superimposing various transparent templates selected based on the shape of a user's face, eyes, lips, eyebrows, eye color and "the nature of her skin." Accordingly, Bourjois' color compatibility method is a subjective one, wherein the color compatibility of cosmetic products to a user's skin is determined by the judgment and opinion of the person practicing the method.

In contrast, MacFarlane describes an empirical personal color assessment method, directed to calculating a single parameter based on the blue and yellow content of a person's skin. See column 2, lines 25-30. MacFarlane characterizes its method as a superior one over conventional methods, by describing its method as a "scientifically sound and readily reproducible personal color assessment method" wherein "skin coloration is accurately measured in a consistent, repeatable fashion." See column 2, lines 25-26 and 36-38.

MacFarlane generally discredits subjective color assessment methods, such as the method taught by Bourjois, by describing that "numerous proposals for identifying colors of, for example...makeup...based upon an individual's person's coloration have been put forth. Some of these proposed techniques have taken into account the color of the person's complexion, but...have also wrongly relied upon eye color...Often this has been misleading in that the true scientific basis for skin color categorization was not perceived." See column 1, lines 26-49.

Therefore, MacFarlane teaches that empirical color assessment methods involving quantification of a single parameter is far superior to subjective methods, such as the method taught by Bourjois. Accordingly, no reason or rationale exists for one of ordinary skill in the art practicing MacFarlane's method to have turned to the teachings of Bourjois, which describes a subjective color assessment method.

Accordingly, because it is improper to combine the teachings of Bourjois and MacFarlane in the first place, for at least this additional reason, the applied references would not have rendered obvious independent claims 1 and 2 or any of the claims dependent therefrom.

F. The Examiner Fails To Establish A *Prima Facie* Case Of Obviousness Of The Claims

The Examiner fails to establish *prima facie* obviousness of independent claims 1 and 2 and the claims dependent therefrom. The Examiner generally categorizes the specific combination of the numerous specific limitations recited in claims 1 and 2 as "functional parameters," and improperly shifts the burden to the Applicants to demonstrate the non-obviousness of claims 1 and 2. See page 2 of the January 23, 2008 Office Action ("Where functional parameters such as the instant hue angle, saturation, covering values, etc. are recited and the prior art discloses otherwise similar prior art, the burden is on the applicant to demonstrate the unobviousness of those parameters").

The Examiner fails to first establish how the device taught by Bourjois, or the method of color characterization using skin color as the exclusive determining factor taught by MacFarlane, alone or in combination, teach or suggest a foundation cosmetic composition that is "otherwise similar" to the claimed foundation cosmetic compositions. In fact, neither reference discloses any particular cosmetic compositions. Therefore, because the Examiner fails to articulate reasoning with some rational underpinning to support the legal conclusion of obviousness, the Examiner fails to establish a conclusion of *prima facie* obviousness and the rejection of claims 1 and 2 and the claims dependent therefrom are improper.

The Examiner cites to *In re Greenfield*, 571 F.2d 1185 (CCPA 1978) and alleges that "Where functional parameters such as the instant hue angle, saturation, covering values, etc. are recited and the prior art discloses otherwise similar prior art, the burden is on applicant to

demonstrate the unobviousness of those parameters." See page 2 of the January 23, 2008 Office Action.

First, it is unclear to what the term "functional parameters" refer. Second, nowhere in *In re Greenfield* are "functional parameters" discussed. Moreover, because the Examiner mischaracterizes *In re Greenfield*, the facts and holding of *In re Greenfield* cannot be properly applied to this case.

In *In re Greenfield*, the appealed claims, directed to a paint composition containing 3-isothialozone as a mildewcide and formaldehyde as a stabilizer for the 3-isothiazolone, were rejected under 35 U.S.C. §103 as having been obvious over either of two applied patents, each of which taught that both 3-isothiazolones and formaldehyde are known to be useful as biocides in coating compositions. 571 F.2d, 1185 at 1187. On appeal to the Board of Patent Appeals and Interferences, the Board concluded that it would have been obvious to combine 3-isothiazolones and formaldehydes to arrive at the appealed claims. *Id.* The Board further noted that the mere fact that appellants "observed" that the formaldehyde stabilizes the 3-isothiazolones, without more, was not sufficient to negate the *prima facie* obviousness of combining two biocides, because appellants had not established that chemical degradation was a problem with respect to all 3-isothiazolones under the claimed conditions. *Id.*

On appeal to the United States Court of Customs and Patent Appeals, appellants "acknowledged that the appealed claims would have been *prima facie* obvious over [the 2 applied references]. See *id.* Therefore, the sole issue for resolution is whether appellants have rebutted this *prima facie* case." See *id.*

Appellants argued that the *prima facie* case of obviousness is rebutted by a showing that, under the claimed pH conditions, the presence of the formaldehyde in the claimed paint composition had the unexpected property of stabilizing the 3-isothiazolones. However, the Court found that the validity of such an argument depended on whether it has been

demonstrated that the claimed 3-isothiazolones normally decompose under the claimed conditions. *Id.* at 1187-88.

Accordingly, only when the Examiner met his burden of establishing a *prima facie* case of obviousness, did the burden to rebut such a *prima facie* finding shift to the Applicant. Additionally, the issue in *In re Greenfield* was not "functional parameters," but instead, the sufficiency of the appellant's proof of an alleged unexpected results achieved by the claimed composition in order to rebut the *prima facie* case of obviousness.

Unlike the situation in *In re Greenfield*, the Examiner has not met his initial burden to establish a *prima facie* case of obviousness of the claims on appeal. Therefore, the Examiner still has the initial burden of proving a *prima facie* case of obviousness of claims 1 and 2, and the Examiner's shifting of the burden to Appellants by requiring Appellants to demonstrate the non-obviousness of claims 1 and 2 and the claims dependent therefrom are improper.

Also unlike the situation in *In re Greenfield*, Appellants do not attempt to demonstrate non-obviousness of the claimed invention by establishing unexpected results achieved by the claimed invention. Instead, Appellants respectfully submit that there exists no reason or rationale for one of ordinary skill in the art to have combined the teachings of MacFarlane and Bourjois, or even improperly having done so, to produce the claimed invention.

For at least the foregoing reasons, the combined teachings of MacFarlane and Bourjois would not have rendered obvious independent claim 1 and 2 or the claims dependent therefrom.

G. Conclusion

For all the reasons set forth above, it would not have been obvious for one of ordinary skill in the art to have combined the teachings of Bourjois and MacFarlane to have arrived at the composition of independent claims 1 and 2 or the claims dependent therefrom.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-15 and 34-38 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 1-15 and 34-38.

Respectfully submitted,



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APPENDIX A - CLAIMS APPENDIX**CLAIMS INVOLVED IN THE APPEAL:**

1. A foundation cosmetic composition comprising, in a physiologically acceptable medium:
 - at least one coloring agent having a yellow or orange coloration and having a significant reflectance in the range from 550 to 675 nm; and
 - reflective particles,
 said composition having a reflectance ranging from 10 to 45 % in the range from 600 to 680 nm,
 said composition having a homogenization power $1/\Delta E_1$ and a covering power $1/\Delta E_2$ below, when it is applied, according to the value of its lightness L^* , to one of the following contrast cards:
 - when the composition has a lightness L^* of between 30 and 40, when it is applied to a contrast card with five zones each respectively having as colorimetric coordinates, to within 15% for L^* and hue angle value h , and to within 25% for saturation C^* ,

- first zone (B11+) : $L^* = 36.7$ $C^* = 19.81$ $h = 47.34^\circ$,
- second zone (B11) : $L^* = 38.43$ $C^* = 21.76$ $h = 46.51^\circ$,
- third zone (B12) : $L^* = 35.66$ $C^* = 19.78$ $h = 46.32^\circ$,
- fourth zone (B12+) : $L^* = 32.98$ $C^* = 17.29$ $h = 44.64^\circ$,
- fifth zone (XXX) : $L^* = 29.63$ $C^* = 15.06$ $h = 40.34^\circ$,

said contrast card further having a white border,

the composition has a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between about 1.1 and about 6.7, and a covering power $1/\Delta E_2$ of between about 0.25 and about 0.85,

wherein $\Delta E_{1 \text{ mean}} = (\Delta E_{1 \text{ B11/B11+}} + \Delta E_{1 \text{ B12/B11+}} + \Delta E_{1 \text{ B12+/B11+}} + \Delta E_{1 \text{ XXX/B11+}})/4$; and

wherein ΔE_2 is the colorimetric difference between zone B11+ and the white border;

- when the composition has a lightness of between 40 and 50, when it is applied to a contrast card with five zones each respectively having as colorimetric coordinates, to within 15% for L^* and h , and to within 25% for C^* ,

- first zone (C9) : $L^* = 45.04$ $C^* = 25.18$ $h = 53.27^\circ$,
- second zone (B12) : $L^* = 35.66$ $C^* = 19.78$ $h = 46.32^\circ$,
- third zone (C11) : $L^* = 38.73$ $C^* = 21.94$ $h = 50.18^\circ$,
- fourth zone (C10) : $L^* = 42.19$ $C^* = 24.18$ $h = 51.94^\circ$,
- fifth zone (C8) : $L^* = 48.06$ $C^* = 25.97$ $h = 53.09^\circ$,

said contrast card further having a white border,

the composition has a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between about 1.1 and about 1.54, and a covering power $1/\Delta E_2$ of between about 1/9 and 1/5,

wherein $\Delta E_{1 \text{ mean}} = (\Delta E_{1 \text{ C8/C9}} + \Delta E_{1 \text{ C10/C9}} + \Delta E_{1 \text{ C11/C9}} + \Delta E_{1 \text{ B12/C9}})/4$; and

wherein ΔE_2 is the colorimetric difference between zone C9 and the white border;

- when the composition has a lightness of between 50 and 60, when it is applied to a contrast card with five zones each respectively having as colorimetric coordinates, to within 15% for L^* and h , and to within 25% for C^* ,

- first zone (D6) : $L^* = 54.08$ $C^* = 26.70$ $h = 57.35^\circ$,
- second zone (C11) : $L^* = 38.73$ $C^* = 21.94$ $h = 50.18^\circ$,
- third zone (D8) : $L^* = 47.94$ $C^* = 26.18$ $h = 56.82^\circ$,
- fourth zone (D7) : $L^* = 51.79$ $C^* = 27.21$ $h = 57.09^\circ$,
- fifth zone (D5) : $L^* = 57.61$ $C^* = 26.22$ $h = 55.09^\circ$,

said contrast card further having a white border,

the composition has a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between about 0.8 and about 1.25 and a covering power $1/\Delta E_2$ of between about 1/7 and 1/3,

wherein $\Delta E_{1 \text{ mean}} = (\Delta E_{1 \text{ D5/D6}} + \Delta E_{1 \text{ D7/D6}} + \Delta E_{1 \text{ D8/D6}} + \Delta E_{1 \text{ C11/D6}})/4$; and

wherein ΔE_2 is the colorimetric difference between zone D6 and the white border;

wherein L^* , C^* and h refer to coordinates in the CIE 1976 colorimetric space,

wherein $\Delta E_{1\ M/N} = [(a_M^* - a_N^*)^2 + (b_M^* - b_N^*)^2 + (L_M^* - L_N^*)^2]^{1/2}$; and

wherein a^* and b^* are coordinates in the CIE 1976 colorimetric space.

2. A foundation cosmetic composition comprising, in a cosmetically acceptable medium:

at least one coloring agent, having a yellow or orange coloration and having a significant reflectance in the range from 550 to 675 nm; and

- reflective particles,

said composition having a reflectance ranging from 10 to 45 % in the range from 600 to 680 nm,

said composition having, when it is applied to a contrast card with five zones each respectively having as colorimetric coordinates, to within 5%:

- first zone (Z1) :	$L^* = 48.38$	$a^* = 7.99$	$b^* = 3.85$
- second zone (Z2) :	$L^* = 46.67$	$a^* = 6.78$	$b^* = 3.25$
- third zone (Z3) :	$L^* = 44.5$	$a^* = 6.76$	$b^* = 3.1$
- fourth zone (Z4) :	$L^* = 42.72$	$a^* = 4.12$	$b^* = 2.57$
- fifth zone (Z5) :	$L^* = 44.41$	$a^* = 6.57$	$b^* = 3.93$

a sixth zone (Z6) having as colorimetric coordinates

$$L^* = 52.26 \quad a^* = 9.11 \quad b^* = 5.81,$$

and a white border,

a homogenization power $1/\Delta E_{1\text{mean}}$ of between 1/4 and 1, and a covering power $1/\Delta E_2$ of between 1/25 and 1/7,

wherein $\Delta E_{1\text{ mean}} = (\Delta E_{1\text{ zone Z1/Z6}} + \Delta E_{1\text{ zone Z2/Z6}} + \Delta E_{1\text{ zone Z3/Z6}} + \Delta E_{1\text{ zone Z4/Z6}} + \Delta E_{1\text{ zone Z5/Z6}})/5$

with $\Delta E_{1 \text{ zone } Zi/Z6} = [(a^*_{Zi} - a^*_{Z6})^2 + (b^*_{Zi} - b^*_{Z6})^2 + (L^*_{Zi} - L^*_{Z6})^2]^{1/2}$, for $i = 1, 2, \dots, 5$,
 wherein ΔE_2 is the colorimetric difference between the sixth zone (Z6) and the white border;
 and wherein L^* , a^* and b^* refer to coordinates in the CIE 1976 colorimetric space.

3. The composition according to claim 2, said composition having a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between 1/1.6 and 1/2 and a covering power $1/\Delta E_2$ of between 1/12 and 1/15.
4. The composition according to claim 2, said composition having a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between 1/1.8 and 1/2.2 and a covering power $1/\Delta E_2$ of between 1/13 and 1/17.
5. The composition according to claim 2, said composition having a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between 1/1.6 and 1/2.1 and a covering power $1/\Delta E_2$ of between 1/12 and 1/16.
6. The composition according to claim 2, said composition having a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between 1/2.6 and 1/3 and a covering power $1/\Delta E_2$ of between 1/16 and 1/21.
7. The composition according to claim 2, said composition having a homogenization power $1/\Delta E_{1 \text{ mean}}$ of between 1/1.7 and 1/2.2 and a covering power $1/\Delta E_2$ of between 1/9 and 1/13.
8. The composition according to claim 1, said composition being liquid at room temperature.
9. The composition according to claim 2, said composition being liquid at room temperature.
10. A method for making up dark skin, comprising applying to the skin a composition as defined in claim 1.

11. A method for making up dark skin, comprising applying to the skin a composition as defined in claim 2.
12. A method for lightening dark skin, comprising applying to the skin a composition as defined in claim 1.
13. A method for lightening dark skin, comprising applying to the skin a composition as defined in claim 2.
14. The composition according to claim 1, wherein the values of L^* and h are given with a tolerance selected from the group consisting of: within 12.5%, within 7.5%, and within 5%.
15. The composition according to claim 1, wherein the values of C^* are given with a tolerance selected from the group consisting of: within 20%, within 15%, within 10%, and within 5%.
34. The composition according to claim 1, wherein when the composition has a lightness of between 30 and 40, the composition has a homogenization power $1/\Delta E_{I \text{ mean}}$ of between about 1.25 and about 5.
35. The composition according to claim 1, wherein when the composition has a lightness of between 40 and 50, the composition has a homogenization power $1/\Delta E_{I \text{ mean}}$ of between about 1.1 and about 1.43.
36. The composition according to claim 2, said composition having a homogenization power $1/\Delta E_{I \text{ mean}}$ of between $1/3$ and $1/2$.
37. The composition according to claim 1, wherein when the composition has a lightness of between 40 and 50, the composition has a covering power of $1/\Delta E_{2 \text{ mean}}$ of between $1/8$ and 0.15.
38. The composition according to claim 2, said composition having a covering power $1/\Delta E_{2 \text{ mean}}$ of between $1/21$ and $1/10$.

APPENDIX B - EVIDENCE APPENDIX

NONE

APPENDIX C - RELATED PROCEEDINGS APPENDIX

NONE